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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,657	01/28/2002	Toshihiko Suenaga	SIW-031	3863
959	7590	05/23/2005	EXAMINER	
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			DOVE, TRACY MAE	
			ART UNIT	PAPER NUMBER
			1745	
DATE MAILED: 05/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/058,657

Applicant(s)

SUENAGA ET AL.

Examiner

Tracy Dove

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/27/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to the communication filed on 3/15/05. Applicant's arguments have been considered, but are not persuasive. Claims 1-8 and 10-19 are pending. Claims 10-19 are withdrawn as being directed toward a non-elected invention. This Action is FINAL.

Election/Restrictions

Applicant's election of 3/12/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an insulating picture frame-shaped member attached to a single separator, does not reasonably provide enablement for an insulating picture frame-shaped member attached to more than one separator. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. As clearly shown in at least Figures 2-15, a separate picture frame-shaped member (61, 81, 91, etc.) is attached to each separator 3. Thus the claims must recite at least a first and a second insulating picture frame-shaped member wherein the first frame-shaped member is attached to both sides of a first separator and the

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second frame-shaped member is attached to both sides of a second separator. The first and second frame-shaped members abut each other to seal the space between adjacent separators.

Claim 5 is similarly rejected for reciting “wherein a peripheral end surface of each of said separators is covered by said picture frame-shaped member”. A single frame-shaped member only contacts a single separator peripheral end surface.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to support “an insulating outer edge member for covering an outermost portion of said reaction surface peripheral sealing member”. Specifically, the specification does not support a reaction surface peripheral sealing member that is covered/coated.

*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitations “a first picture frame-shaped member” and “a second picture frame-shaped member”. However, claim 1 already recites “a picture frame-shaped member”. Therefore, there is improper antecedent basis for these limitations in the claim.

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Claim 6 recites “a reaction surface peripheral sealing member which surrounds a corrugated portion of each of said separators”, which is confusing and unclear. It is unclear how the sealing member “surrounds” a corrugated portion”. Furthermore, the separator does not “react” so it is unclear what constitutes “a reaction surface”.

Claim 7 recites the limitation "an insulating outer edge member for covering an outermost portion of said reaction surface peripheral sealing member". It is unclear how the “insulating outer edge member” covers the reaction surface peripheral sealing member and is integrally formed with the reaction surface peripheral sealing member. If the insulating outer edge member “for covering” the reaction surface peripheral sealing member, it doesn’t appear that the insulating outer edge member would be “integrally formed” with the reaction surface peripheral sealing member.

Claim 8 recites the limitations "a first reaction surface peripheral sealing member" and “a second reaction surface peripheral sealing member”. However, claim 6 already recites “a reaction surface peripheral sealing member”. Therefore, there is improper antecedent basis for these limitations in the claim.

Response to Arguments

Applicant's arguments filed 3/15/05 have been fully considered but they are not persuasive. The rejection of claims 1-8 under 35 U.S.C. 112, 1st and 2nd paragraph, is maintained.

Applicant argues that claim 1 has been amended to recite that the insulating picture frame-shaped member is attached to each of the separators. However, as clearly disclosed in at least the figures of the present specification, each frame-shaped member is attached to a single

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separator (a single frame shaped member is not attached to more than one separator). This argument is also applied to claim 5 and is not persuasive for the same reasons.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is 571-272-1285. The examiner can normally be reached on Monday-Thursday (9:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


TRACY DOVE
PRIMARY EXAMINER

May 17, 2005